

## **REMARKS**

Claims 1-20 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

### **Section 103(a) Rejections:**

The Office Action rejected claims 1, 2, 5, 7, 8, 12-15, 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Harrell et al. (U.S. Publication 2002/0156656) (hereinafter “Harrell”) in view of [www.pipinsure.com](http://www.pipinsure.com) (<http://web.archive.org/web/20000619183651/http://www.pipinsure.com/welcome.html>) (hereinafter “Pipinsure”) in further view of Keuper (DE 44 46 203) (hereinafter “Keuper”), claim 3 as being unpatentable over Harrell in view of Pipinsure and Keuper and further in view of Welles et al. (U.S. Patent 5,686,888) (hereinafter “Welles”), claims 4, 6, 9-11, 16 and 17 as being unpatentable over Harrell in view of Pipinsure and Keuper and further in view of Bennett et al. (U.S. Patent 7,117,170) (hereinafter “Bennett”), and claim 18 as being unpatentable over Harrell and Pipinsure and Keuper and further in view of Kepler (U.S. Patent 5,347,845) (hereinafter “Kepler”). Applicant respectfully traverses these rejections for at least the following reasons.

### **Claim 1**

In regard to claim 1, the cited art fails to teach or suggest i) searching a database to select particular insurance for the item according to one or more insurance criteria, wherein the particular insurance provides a specified level of insurance coverage for the item during said shipment, ii) generating a data file comprising at least the following: item information including one or more characteristics of the item, and insurer information indicating one or more terms of said particular insurance, and iii) storing the data file in a memory device that accompanies the item during said shipment.

**1. The cited references, whether considered singly or in combination, fail to teach the generation of the *specific* type of data file of claim 1 and the storing of that *specific* data file in a memory device that accompanies the item during said shipment, according to the specific limitations of claim 1.**

Harrell teaches a storage media and method for selling cargo insurance in a network environment (e.g., “online”) (Harrell, Abstract). According to the Harrell reference, a user seeking insurance for cargo can provide data as part of a quotation process (Harrell, Paragraph [0043]). This data may include information “regarding commodity, departure and arrival locations, mode of conveyance, estimated departure date, invoice value, amount of insured and currency” (Harrell, Paragraph [0043]). The Examiner appears to consider this data as being equivalent to “item information including one or more characteristics of the item” as recited in Applicant’s claim. Presumably this data is received by Harrell’s “all encompassing cargo insurance system” (Harrell, Paragraph [0032]) since such system performs “calculation[s]” based on the data (Harrell, Paragraph [0043]).

In regard to “insurer information indicating one or more terms of said particular insurance,” the Examiner cites various portions of Harrell including paragraph [0048]. In paragraph [0048] Harrell teaches that at some point the user is “asked to review the terms and conditions of the contract.” Since the user is “asked to review the terms and conditions of the contract,” Harrell’s “all encompassing cargo insurance system” presumably has access to information specifying the terms and conditions.

While it appears that Harrell’s “all encompassing cargo insurance system” has some sort of *access* to information “regarding commodity, departure and arrival locations, mode of conveyance, estimated departure date, invoice value, amount of insured and currency” (Harrell, Paragraph [0043]) as well as *access* to “terms and conditions of the contract” (Harrell, Paragraph [0048]), Harrell does not provide any specific information as to where such information resides or how such information is stored within a computer. **More specifically, at no point does Harrell (even when**

considered with Pipinsure and Keuper) teach or suggest “generating a data file comprising at least the following: item information including one or more characteristics of the item, and insurer information indicating one or more terms of said particular insurance,” much less “storing the data file [that comprises both the item information and the insurer information] in a memory device that accompanies the item during said shipment.” The Examiner has failed to provide any evidence of record that teaches this *specific* type of data file, much less the storing of this specific type of data file within a memory device that accompanies the item during shipment.

Contrary to the Examiner’s assertion that Harrell teaches “storing the data file in a memory device” in Figure 1 of Harrell, Harrell (even when considered in light of Pipinsure and Keuper) does not actually teach or suggest this aspect of Applicant’s claim, much less teach or suggest “storing the data file [that comprises both the item information and the insurer information] in a memory device that accompanies the item during said shipment.” **In fact, such a data file is not present within the teachings of the cited art. Simply because Figure 1 of Harrell recites the phrase “stored data” does not mean that the cited art teaches a specific type of data file that includes both a specific type of item information and a specific type of insurer information as claimed.** Harrell, even when considered with Pipinsure and Keuper, fails to teach this specific type of data file, much less storing such data file in a memory device that accompanies the item during shipment.

If the Examiner intends to maintain the current rejection based on the current evidence of record, the **Applicant respectfully requests the Examiner** point out the **specific element of the cited art** that is considered as being equivalent to a data file that adheres to the *specific* limitations of claim 1. As the Examiner is certainly aware, 37 CFR 1.104(c)(2) states that “[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable” (emphasis added). **The Examiner has not met this requirement.**

The teachings of Pipinsure and Keuper fail to overcome the deficiencies of Harrell. Pipinsure teaches a website for procuring a savings quote based on a customer's aggregate shipping habits. The teachings of Pipinsure, whether considered singly or in combination with the other cited references, having nothing to do with generating the *specific* type of data file claimed, much less storing such a data file in a memory device that accompanies the item during shipment.

Keuper teaches a "barrel tag transponder" that includes "filling data," which is clearly different than the specific type of data file claimed. For instance, Keuper describes on page 8, lines 3-11:

This problem is solved in the following manner: during (or after) the filling of the barrel, filling data, such as the filling date and identification concerning the type of fluid charged in such as the beer grade, the filling volume, a sequential filling number, etc. are transmitted from the transmitting/receiving device to the transponder and are there stored as data set in a poll able manner is [sic] such a way that the data even at a later point in time cannot only be read out elsewhere but can also be updated. (emphasis added)

As shown above, the "filling data" described by Keuper is very different than the specific type of data file recited in claim 1. More specifically, the "filling data" stored in Keuper's "barrel tag transponder" is not a data file comprising at least the following: item information including one or more characteristics of the item, and insurer information indicating one or more terms of said particular insurance," as recited in claim 1. **As can readily be seen by reviewing the above cited portion of Keuper, the data stored in Keuper's barrel tag transponder does not include insurer information, much less the particular type of insurer information claimed.** Instead, Keuper makes it very clear that the information stored in his "barrel tag transponder" is information pertaining to filling a beer keg with beer, which is clearly different than a data file that includes item information as well as insurer information indicating one or more terms of insurance. **The Examiner has not presented evidence of record that teaches or suggests the generation of the *specific* type of data file recited in Applicant's claim, nor has the Examiner presented evidence of record that teaches or suggests the storing of this specific type of data file within a memory device that accompanies an**

**item during shipment.** A beer tag transponder that includes information pertaining to filling a keg with beer, even when considered in light of all the cited references, is simply not commensurate with the actual limitations of claim 1. For at least these reasons, Pipinsure and Keuper fail to overcome the deficiencies of Harrell.

**2. Furthermore, the cited art fails to teach or suggest searching a database to select particular insurance for the item according to one or more insurance criteria, wherein the particular insurance provides a specified level of insurance coverage for the item during said shipment.** The Examiner cites pages 2, 8 and 9 of Pipinsure with respect to this limitation. Pipinsure discloses a series of questions a user can answer to “request a free quote on your package insurance needs.” The questions pertain to *general characteristics* of a user's shipping *habits* including *average* number of packages insured per day and *average* value per insured package. **The whole point of the Pipinsure reference is to provide a customer with a *savings quote* based on aggregate shipping characteristics. The Pipinsure reference, considered singly or in combination with the other cited references, does not actually teach or suggest selecting *particular* insurance for an item during shipment from an origination to a final destination.** Moreover, Pipinsure certainly does not teach *searching a database* to select particular insurance for the item according to one or more insurance criteria, wherein the particular insurance provides a specified level of insurance coverage for the item during said shipment. The teachings of Harrell and Keuper fail to overcome the deficiencies of Pipinsure with respect to this claim limitation. Neither Keuper's beer tag transponder system nor Harrell's method for obtaining marine cargo insurance teach or suggest any thing at all about searching a database to select particular insurance according to the specific limitations of claim 1.

**3. Applicant asserts the Examiner has failed to provide a proper reason as to why one of ordinary skill in the art would have been motivated to combine the teachings of Keuper with the teaching of Harrell and Pipinsure.** The Examiner asserts:

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method comprising a memory device that accompanies an item during said shipment as taught by Keuper, within the method of Harrell and Pipinsure, with the motivation of acquiring shipment handling data on an item. (Final Office Action of December 7, 2009; pages 3 – 4; emphasis added)

However, Harrell alone provides mechanisms for “acquiring shipment handling data on an item.” For instance, in paragraph [0043] of the Harrell reference, it is clear that Harrell’s system receives “mode of conveyance” information for a cargo shipment via a “quote creation process.” Since the “mode of conveyance” information for a cargo shipment clearly falls within the scope of “shipment handling data on an item” and since Harrell’s system includes a “quote creation process” to receive such information, Harrell’s system is already equipped to “acquir[e] shipment handling data on an item.” Accordingly, one seeking to “acquir[e] shipment handling data on an item” would simply use the teachings of Harrell alone, not combine the teachings of Harrell with the teachings of another reference, much less the teachings of Pipinsure and Keuper. The Examiner has merely provided a reason to use the teachings of Harrell alone, not a reason to combine the teachings of Harrell with Pipinsure and Keuper.

As the Examiner is certainly aware, “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (emphasis added). *KSR v. Teleflex*, 550 U.S. 398 (2007), 82 USPQ2d 1385, 1396. **Since the Examiner’s proposed reasoning fails to meet this standard, the Examiner’s rejection is improper.**

Moreover, Keuper is non-analogous art. Keuper is directed to the art of processing beer kegs, which has nothing to do with Harrell, Pipinsure or Applicant’s claimed invention.

**4. The rejection is improper because the Examiner did not even attempt to provide a reason as to why one of ordinary skill in the art would have been**

**motivated to combine the teachings of *Pipinsure* with the teachings of Harrell and Keuper.**

In the Final Office Action of December 7, 2009 (pages 3 – 4), the Examiner provides an alleged reason as to why one of ordinary skill in the art would have been motivated to combine the teachings of *Keuper* with the teachings of *Pipinsure* and Harrell. However, the Examiner provides no reason as to why one of ordinary skill in the art would have been motivated to combine the teachings of *Pipinsure* with the teachings of Harrell and Keuper.

As the Examiner is certainly aware, “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (emphasis added). *KSR v. Teleflex*, 550 U.S. 398 (2007), 82 USPQ2d 1385, 1396. **Since the Examiner has not even attempted to provide such reasoning with respect to combining the teachings of *Pipinsure* with the teachings of the other cited references, the Examiner’s rejection is improper.**

Moreover, Keuper is non-analogous art. Keuper is directed to the art of processing beer kegs, which has nothing to do with Harrell, *Pipinsure* or Applicant’s claimed invention.

**5. Furthermore, the Harrell reference has not been shown to be prior art to the present application.**

Harrell is a published U.S. patent application that was filed on Aug. 28, 2001, **after** the priority date established by Applicant's provisional application (U.S. Provisional Application No. 601246,640, filed Nov. 10, 2000). Harrell does claim the benefit of a provisional application filed Aug. 29, 2000. However, Harrell's published application is not entitled to the Aug. 29, 2000 date as a section 103(a) prior art date unless at least one claim of Harrell's published application is supported (under 35 U.S.C.

§ 112) in the provisional application. **Under 35 U.S.C. 119(e)(1), a published utility application is not entitled to its provisional application's filing date as a prior art date unless at least one claim of the published utility application is supported (per 35 U.S.C. § 112) in the provisional application.** The rejection is improper unless the Examiner can show that Harrell's published application has the necessary claim support in the provisional application to be entitled to the provisional application's filing date as its § 103(a) prior art date. *See also* M.P.E.P. § 2136.03(IV). The Examiner's remarks in the response to arguments section of the Final Office Action of December 7, 2009 only address the common subject matter requirement. **The Examiner did not address the requirement for a claim of the published utility application to be supported (per 35 U.S.C. § 112) in the provisional application.**

In fact, it appears that none of the claims of Harrell's published application are supported (under 35 U.S.C. § 112) in the provisional application. For example, claim 1 of Harrell's published application recites the following claim limitations:

- b) upon acceptance of said cargo insurance policy quotation by said customer on-line, generating a bill on-line corresponding to said cargo insurance policy quotation, [and]
  - c) upon acceptance of said bill by said customer on-line, issuing a cargo insurance certificate on-line to said customer
- (Harrell; page 8, claim 1; emphasis added)

Claim 1 of Harrell's published application recites "generating a bill on-line corresponding to said cargo insurance policy quotation." While Harrell's provisional application makes multiple references to a "billing process," Harrell's provisional application fails to actually mention a "bill" anywhere, much less "generating a bill on-line corresponding to said cargo insurance policy quotation." Furthermore, while Harrell's provisional application does mention that a certificate can be issued, Harrell's provisional application fails to support the *temporal requirement* of issuing a cargo insurance certificate on-line to said customer *upon acceptance of said bill by said customer on-line*. Harrell's provisional application mentions nothing at all about a "bill," generating a bill online, or the acceptance of such a bill by a customer on-line. These aspects of claim 1 of Harrell's published application do not appear to be supported (under

35 U.S.C. § 112) in the provisional application. Similar remarks apply to claim 15 of Harrell's published application, which contains limitations similar to those addressed above with respect to claim 1 of Harrell's published application.

The Examiner has the burden of proof to produce the factual basis for the rejection. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). Since the Examiner has not proven that the above requirement has been met for Harrell's teachings to qualify as prior art, the Examiner has not met this burden of proof and the rejection is improper.

**6. Furthermore, the Pipinsure reference has not been shown to be prior art to the present application.** The Examiner has not properly established a publication date of the Pipinsure reference. The Examiner relies on the website <http://www.archive.org> for establishing that the Pipinsure reference was available as of 2000. However, there is no guarantee that the dates or even the content of what is supplied by <http://www.archive.org> is accurate. Applicant notes that the Terms of Use for <http://www.archive.org> (see <http://www.archive.org/about/terms.php> ) state:

You understand and agree that the Archive makes no warranty or representation regarding the accuracy, currency, completeness, reliability, or usefulness of the content in the Collections, that the Site or the Collections will meet your requirements, that access to the Collections will be uninterrupted, timely, secure, or error free, or that defects, if any, will be corrected. We make no warranty of any kind, either express or implied.

**Thus, since <http://www.archive.org> does not guarantee the accuracy of its collections, Applicant asserts that it is not proper to rely on <http://www.archive.org> to establish a publication date.** Furthermore, even if the Pipinsure reference was published prior to Applicant's date of invention, there is no guarantee that the copy downloaded by the Examiner is an *accurate copy of what was published*. **This is especially true since <http://www.archive.org> specifically states that they do not guarantee the accuracy of their content.**

For the above reasons, Applicant asserts that there is insufficient evidence of record to establish that the Pipinsure reference downloaded by the Examiner qualifies as prior art. Also, as noted above, even if the Pipinsure reference is prior art, Pipinsure in view of the other cited references fails to teach or suggest the specific limitations of claim 1.

Thus, for at least the reasons presented above, the rejection of claim 1 is not supported by the cited art and removal thereof is respectfully requested.

### **Claims 19 and 20**

The rejection of claims 19 and 20 is not supported by the cited art for at least reasons presented above with respect to claim 1.

Furthermore, the Office Action failed to state a *prima facie* rejection of claims 19 and 20 because the Office Action failed to address specific limitations of 19 and 20. For instance, claim 19 recites "search a database to select particular insurance for the item according to one or more insurance criteria, **wherein the particular insurance provides maximum insurance coverage for the item during said shipment for the least cost**" (claim 20 includes a similar limitation). The Office Action rejected claims 19 and 20 for under the rationale used to reject claims 1, 2 and 6 (see page 6 of December 7, 2009 Office Action). However, claims 1, 2, and 6 are **not** commensurate with the aforesaid claim limitation of claim 19. None of claims 1, 2 and 6 recite "search a database to select particular insurance for the item according to one or more insurance criteria, wherein the particular insurance provides *maximum* insurance coverage for the item during said shipment for the *least* cost." Accordingly, the Office Action failed to state a *prima facie* rejection of claims 19 and 20. Nor does the cited art teach or suggest the aforesaid limitation of Applicant's claim.

### **Claim 7**

**The cited art fails to teach or suggest shipping the item using the least expensive routing.** The Examiner cites Figure 2 of Harrell and asserts “Harrell discloses modifications can determine the least expensive routing (i.e., lower premiums).” However, the cited portion of Harrell does not teach “modification can determine the least expensive routing.” The Figure does reference a change that “Would Result in Lower/Different Premium.” However, a premium is the cost of insurance, not the cost of shipping. This portion of the cited art is simply not commensurate with the specific limitations of Applicant’s claim.

Thus, for at least the reasons presented above, the rejection of claim 7 is not supported by the cited art and removal thereof is respectfully requested.

### **Claim 8**

**The cited art fails to teach or suggest wherein the data file further comprises contact information for at least one insurance company that will provide said insurance.** The Examiner cites Figures 12 and 14 of Harrell and asserts “where Harrell discloses a reinsurer is notified in Figure 12, thus it is reasonable to conclude that the reinsurers contact information is available” and “Figure 14 illustrates contact of a claims representative and underwriter.” Irrespective of the correctness of the Examiner’s assertions, the “data file” of claim 8 is the data file stored in a memory device that accompanies the item during said shipment, as recited in claim 1. Nowhere does Harrell or any other evidence of record teach or suggest that “reinsurers contact information” or “representative and underwriter” contact information is stored as part of such a data file. Simply citing contact information outside of the context of a data file stored in a memory device that accompanies the item during said shipment is not sufficient to reject Applicant’s claim. The cited art must actual teach or suggest the *specific* limitations of Applicant’s claim for the rejection to be valid.

Thus, for at least the reasons presented above, the rejection of claim 8 is not supported by the cited art and removal thereof is respectfully requested.

### **Claim 18**

1. In regard to claim 18, the cited art fails to teach or suggest wherein the memory device comprises an air testing device configured to test air samples for contaminants and to store test results in the data file. The Examiner cites column 2, lines 25-35 of Kepler, which is reproduced below:

... probe through the film patch. An air contaminant detection apparatus is interconnected with the probe such that a test sample of air from within the shipping container may be admitted to the air contaminant detection apparatus. A means for indicating the presence of a contaminant is further provided along with an apparatus for sorting the shipping container containing a refrigerator in response to a presence of the contaminant.

Accordingly, an object of the present invention is to detect the presence of contaminants in the air contained in a shipping container.

In the cited portion of Kepler, Kepler does teach an “air contaminant detection apparatus.” However, Kepler teaches that his air contaminant detection apparatus (*see e.g.*, Figure 1, item 30; column 3, lines 30-50) is **separate from and does not accompany Kepler’s shipping container** (*see e.g.*, Figure 1, item 12; column 3, lines 5-29). Since the air contaminant detection apparatus of Kepler is explicitly separate from and does not accompany Kepler’s shipping container, the cited art fails to teach or suggest wherein the memory device comprises an air testing device configured to test air samples for contaminants and to store test results in the data file, as recited in claim 18. No memory device of the cited art (that accompanies an item during shipment) includes an air testing device.

2. Applicant asserts that the Examiner has not provided a proper reason as to why one of ordinary skill in the art would have been motivated to combine the teachings of Kepler with the other cited references.

The Examiner asserts that the motivation for such a combination would have been for the purpose of “detecting the presence of contaminants in shipping containers.” The Examiner’s reasoning is simply a reason to *use* an “air contaminant detection apparatus,” not an actual reason as to why one of ordinary skill in the art would *combine* the teachings of the cited references to form a memory device that *includes* an air testing device and accompanies an item during shipment. Even were one to somehow combine the “air contaminant detection apparatus” of Kepler with the other cited references, such a combination would not result in the inclusion of such a “air contaminant detection apparatus” within Keuper’s beer barrel transponder tags (on which the Examiner presumable relies to teach the claimed “memory device”).

Thus, for at least the reasons presented above, the rejection of claim 18 is not supported by the cited art and removal thereof is respectfully requested.

Applicant also asserts that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time. Applicant reserves the right to present additional arguments.

## **CONCLUSION**

Applicant submits the application is in condition for allowance, and an early notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5596-00901/RCK.

Respectfully submitted,

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